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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/939,151	08/24/2001	Sylvette Maisonnier	ESSR: 052US	3004

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EXAMINER	
TUCKER, PHILIP C	
ART UNIT	PAPER NUMBER
1712	

DATE MAILED: 09/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/939,151	MAISONNIER ET AL.	
	Examiner	Art Unit	
	Philip C. Tucker	1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 June 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *24-66* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *24-28,35,36,39-45,48-57,60-62 and 66* is/are rejected.

7)☒ Claim(s) *29-34,37,38,46,47,58-61 and 63-65* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claim 26 is objected to because of the following informalities: in claim 26, "composition a" should be "composition A". Appropriate correction is required.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 42-45 and 48-54 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 10-25471.

JP '471 teaches a photochromic latex which comprises naphthopyran compounds which is formed using an initiator, such as a persulfate, and monomers such as methacrylates, and wherein a biphasic layer is formed. Such is used to form substrates, such as a lens, which comprises a protective coating over the latex film (see the English translation of the JP document). Such would inherently have the same latex particle size as in the present invention since the same components are used therein. To the extent that JP '471 may not have the same particle size, it would be obvious to

vary the particle size of the latex in order to optimize the photochromic properties of the latex.

4. Claims 42-45, and 48-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 10-25471 in view of Postle (4578305).

JP '471 teaches a photochromic latex which comprises naphthopyran compounds which is formed using an initiator, such as a persulfate, and monomers such as methacrylates, and wherein a biphasic layer is formed (see the English translation of the JP document). JP '471 differs from the present invention in that the size of the latex particles are not specifically disclosed. Postle teaches that variation of the particle size of the latex in a photochromic latex will have a significant impact upon films formed thereby (see columns 5 and 6). The variation of the particle size of the latex of JP '471 in order to obtain improved properties of the photochromic latex, would thus be obvious to one of ordinary skill in the art.

5. Claims 42-45, and 48-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 10-25471 in view of the Declaration by Maisonnier under 37 CFR 1.132 in serial no. 09/991773 and Postle (4578305).

JP '471 teaches a photochromic latex which comprises naphthopyran compounds which is formed using an initiator, such as a persulfate, and monomers such as methacrylates, and wherein a biphasic layer is formed (see the English translation of the JP document). JP '471 differs from the present invention in that the size of the latex particles are not specifically disclosed. With respect to the declaration of Maisonnier, the teachings therein state that the typical latex formed by different methods of emulsion, still have a particle size of 150-250 nm. The utility of a latex with such size would thus be obvious to one of ordinary skill in the art. Furthermore, it would be obvious to one of ordinary skill in the art to vary the size of the latex particles in order to optimize the photochromic properties of the latex (In re Aller 103 USPQ 233, In re Rose 103 USPQ 237). Postle teaches that variation of the particle size of the latex in a

photochromic latex will have a significant impact upon films formed thereby (see columns 5 and 6). The variation of the particle size of the latex of JP '471 in order to obtain improved properties of the photochromic latex, would thus be obvious to one of ordinary skill in the art.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 24-27, 36, 39, 55-57 and 62 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of U.S. Patent no. 6770710 (previous Application No. 09/991773). Although the conflicting claims are not identical, they are not patentably distinct from each other because although US 6770710 differs by using the term primer instead of initiator, the method of the claims of US 6770710 uses the same components as in the present invention, and would be obvious to one of ordinary skill in the art. A miniemulsion is a type of emulsion, and renders the broad teaching of the emulsion of the current claims obvious to one of ordinary skill in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Claims 24-28, 35, 36, 39-45, 48-50, 54-57, 60-62 and 66 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-35 of U.S. Patent No. 6740699. Although the conflicting claims are not identical, they are not patentably distinct from each other because although the use of an initiator is not specified, and the size of the particles or thickness of a film are not disclosed, the claims are obvious to one of ordinary skill in the art for the following reasons. The utility of an initiator for the polymerization of C=C groups in forming a latex is universally known, and is an obvious step in polymerization to one of ordinary skill in the art. US 6740699 in the specification, further teaches the use of water soluble initiators which would render the present claims obvious to one of ordinary skill in the art (see MPEP 804 and Vogel therein). The polymerization to form the photochromic latex

of US 6740699 would clearly lead to a particles having the same size as taught in the present claims such as 42. Furthermore, the variation of particle sizes or film thickness in order to obtain optimum photochromic properties would be an obvious variation to one of ordinary skill in the art (In re Boesch 205 USPQ 213, In re Aller 105 USPQ 233).

9. Claims 29-34, 37, 38, 46, 47, 58-61 and 63-66 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. Applicant's arguments have been considered but are not deemed persuasive. The JP '471 reference uses the same composition as the present invention, and thus would have the same particle size. If the JP '471 reference does not have the specified particle size, it would clearly be obvious to one of ordinary skill in the art to optimize the particle size of the latex of JP '471 in order to obtain optimum photochromic performance. Once a prima facie case has been established, applicant bears the burden of providing evidence that the prior art does not possess the properties of the present invention (In re Biasecki 223 USPQ 785, In re Best 195 USPQ 430). Applicant has not provided any evidence to distinguish over the prior art of JP '471. Applicant has argued that the examiner has not provided any suggestion to modify in the obviousness rejections. Clearly the teaching of Postle that the variation of the particle size of the

latex in a photochromic latex will have a significant impact upon films formed thereby (see columns 5 and 6) is clear motivation for one of ordinary skill to vary the particle size.

Applicant has argued that the Maisonnier declaration has been improperly used since it is not prior art. Since a declaration must contain truthful, i.e. factual evidence, this can clearly be used to establish facts. The present application, and the declaration in the application 09/991773, now a patent US 6770710 are subject to the same Assignment. Since such assignment is the same, the declaration may be properly used herein. Maisonnier is a common inventor in each of the applications, and has provided factual evidence of the particle size. Maisonnier's declaration provides evidence for the latex having a particle size within the specified range, and Poslte provides evidence that a change in particle size does affect the properties of the photochromic latex. Since applicants declaration has provided evidence that whichever method is used to form a typical latex, the particle size is within the scope of the present claims, the rejections under 35 USC 102 and 103 are maintained. A clear motivation is provided to combine Postle and the JP references, since such are in the same field of photochromic latexes. Postle teaches that variation of the particle size of the latex in a photochromic latex will have a significant impact upon films formed thereby (see columns 5 and 6). The variation of the particle size of the latex of JP '471 in order to obtain improved properties of the photochromic latex, would thus be obvious to one of ordinary skill in the art.

With respect to the obviousness double patenting rejection, a miniemulsion is a type of emulsion, and renders the broad teaching of the emulsion of the current claims

obvious to one of ordinary skill in the art. Applicant has not defined such miniemulsion in any form which distinguishes from the present invention. Applicants own patent, US 6740699, subject to the same assignment, and having a common inventor, claims an emulsion in claim 1, and indicates in dependent claim 14 that the emulsion is a miniemulsion. This clearly shows that a miniemulsion is a type of emulsion, or else applicant is arguing that claim 14 of their own patent US 6740699 is invalid. Applicant has also argued that the specific compound is not disclosed. A chromene which is taught in the dependent claims of the '710 patent is exactly the same compound that applicant has in the present claims, thus no distinction is seen. Applicants teaching of an emulsion without any stipulations would read upon all types of emulsions, including miniemulsions, without further definition. Since the specified size of applicants arguments are not a part of the claims, such is not seen as distinguishing. Furthermore, applicant has admitted in the arguments at the top of page 21 of the previous response of 4/9/04, that there is an overlap of the same particle size as being claimed in the present invention. The obviousness double patenting rejection is thus maintained.

With respect to the initiator, clearly the primer, water soluble taught by the '710 patent, and initiator of the present invention are the same. There is thus no distinction seen between them.

A new obviousness double patenting rejection has been presented in view of US 6740699.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip C. Tucker whose telephone number is 571-272-1095. The examiner can normally be reached on Monday - Friday, Flexible schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Philip C Tucker
Primary Examiner
Art Unit 1712

PCT-3209